



Docket Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

EMS-06601

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on February 9, 2007

Signature

Typed or printed name Bonny Rogers

Application Number

10/812,291

Filed

03-29-2004

First Named Inventor

Jerome J. CARTMELL

Art Unit

2189

Examiner

VO, Thanh Duc

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒attorney or agent of record. 33,978

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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February 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jerome J. CARTMELL, et al.

Appl. No.: 10/812,291

Art Unit: 2189

Filed: March 29, 2004

Examiner: VO, Thanh Duc

For: **MIRRORED MEMORY**

Atty. Docket: EMS-06601

STATEMENT SUBMITTED WITH PRE-APPEAL BRIEF REQUEST

This paper is being provided in response to the Final Office Action dated September 15, 2006, and the Advisory Action dated January 18, 2007, received for the above-referenced application, and accompanies a Notice of Appeal and Pre-Appeal Brief Request filed herewith.

As a brief background, in response to the Final Office Action dated September 15, 2006, Applicants submitted a revised Declaration Under 37 C.F.R. 1.131 with two Exhibits (A and B). This revised 131 Declaration was a modified version of a prior 131 Declaration submitted in response to the non-final Office Action dated June 23, 2006, which the Examiner had rejected as failing to establish conception of the invention before the effective date of the reference and for not being signed by all of the inventors. The most recently-submitted revised 131 Declaration was executed by all of the inventors and contained modifications provided in view of the Examiner's comments. The Advisory Action received by Applicants indicates that the revised 131 Declaration will not be considered and that certain amendments have not been entered as being unsupported in the specification. Applicants traverse all of these conclusions as set forth below.

First, in the Advisory Action, with respect to the revised 131 Declaration, the Examiner checked box 8 indicating that "The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 C.F.R. 1.116(e)". Applicants traverse this conclusion. The revised 131 Declaration was a revised version of the previously-submitted 131 Declaration rejected by the Examiner. In the revised 131 Declaration, Applicants supplemented the evidence corroborating conception by the inventors before the effective date of the reference and obtained the signatures of all of the inventors in accordance with the comments by the Examiner. Applicants respectfully submit that the revised 131 Declaration has been timely presented and deserves consideration.

Second, Applicants respectfully submit that the revised 131 Declaration establishes conception of the invention as required under 37 C.F.R. 1.131. This is supported by MPEP 715.07(I) which contains explicit statements reflecting the decision of the Board of Patent Appeals and Interferences in *Ex parte Ovshinsky* 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989). In *Ovshinsky*, the Board specifically states the following:

We point out to the examiner that (1) all the evidence must be considered in its entirety, including the Rule 131 declarations and accompanying exhibits, records and "notes", (2) an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by *the declaration itself*...and (3) it is entirely appropriate for appellants to rely on a showing of facts set forth in the *Rule 131 declarations themselves* to establish conception of the invention prior to the effective date of the reference. (emphasis added)

With respect to establishing conception of the presently-claimed invention, Applicants refer to the revised 131 Declaration and particularly paragraphs (4), (5), (6), (8), (10) and Exhibit

A. In these paragraphs, the inventors specifically assert facts surrounding the conception of the features of the presently-claimed invention. The inventors assert that before February 18, 2004, they developed all of the features of the invention that are presently included in independent claims 1, 10 and 15. In support thereof, the inventors state that before February 18, 2004, they prepared an internal EMC Corporation document that is included as Exhibit A in the 131 Declaration, and they direct specific attention to portions of the Exhibit that address hardware implementation, software requirements and limitations, and software design concepts concerning Symm7 Mirrored Memory and explicitly "Mirrored Memory Hardware Implementation", "6 Different Mirrored Memory System States", "Memory Access Functional Layering" and "Failover and Synchronization State." The inventors also assert facts, in paragraphs (7), (8), (9), (10) and corroborated by Exhibit B, that support the conclusion that, after conception, the inventors were reasonably diligent from a time prior to February 18, 2004, until the invention was constructively reduced to practice by filing the present patent application on March 29, 2004.

Accordingly, Applicants submit that early conception of all of the presently-claimed features of the invention is supported in the revised 131 Declaration taking into account the explicit and detailed statements of facts provided by the inventors and the corroborating evidence provided by Exhibit A, and that the inventors were reasonably diligent for the necessary time, as required under 37 C.F.R. 1.131. In view of the above, Applicants submit that the revised 131 Declaration is sufficient to antedate U.S. Patent App. Pub. No. 2004/0205384 to Lai, et al. filed February 18, 2004.

As to the rejection of claims 10-14 under 35 U.S.C. 112, first paragraph, as lacking support in the specification, Applicants traverse this conclusion. The Examiner asserts that Applicants' specification lacks support for a "computer-readable medium." Applicants respectfully disagree. The specification is filled with references throughout to the use of memories and stored information accessible to software and running on processors. For example, on page 13, lines 8-15, Applicants discuss the use of memory 26 as containing tasks that are to be performed by one or more of disk adapter units, host adapter units and RDF adapter units. Further, on page 18, lines 8-18, Applicants disclose that memory/registers are provided with internal memory that supports the functionality described in the specification. Applicants further describe that DMA chips, chip sets or the equivalent may be used to provide functionality. All of the above are examples of computer-readable media for implementing the presently-claimed invention. Any conclusion that Applicants' specification does not support the recitation of a "computer-readable medium" is egregiously untenable. Accordingly, Applicants respectfully submit that this rejection should be withdrawn.

Moreover, the amendments to claims 10-14 to recite that the software is "stored on a computer-readable medium" were made in response to a rejection of these claims 35 U.S.C. 101 by the Examiner as being directed to non-statutory subject matter. The amendments were made to recite accurately the described subject matter of the claimed invention in view of the guidelines set forth in the MPEP. Specifically, MPEP 2106(IV)(B)(1) states as follows:

[F]unctional descriptive material "consists of data structures and computer programs which impart functionality when encoded on a computer-readable medium. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard

Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) ...When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Accordingly, Applicants traverse the Examiner's conclusion that these amendments "raise new issues" and "are not deemed to place the application in better form for appeal."

Based on the above, Applicants respectfully request that all outstanding rejections and objections be reconsidered and withdrawn. Favorable consideration and allowance are earnestly solicited.